The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 21

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID ROCHON and THOMAS MURRAY

Appeal No. 2002-1917
Application 09/418,509

ON BRIEF

Before KRASS, JERRY SMITH and LEVY, Administrative Patent Judges.

JERRY SMITH, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on the appeal under 35 U.S.C. § 134 from the examiner's rejection of claims 1-37, which constitute all the claims in the application. An amendment after the examiner's answer was filed on March 14, 2002 but has not been entered by the examiner.

The disclosed invention pertains to a computer network implemented method and apparatus for delivering targeted product samples to consumers and measuring consumer acceptance of the samples.

Representative claim 1 is reproduced as follows:

1. A computer network implemented method, comprising the steps of:

transmitting a signal prompting a user to provide profile data including identification of the user from a main computer over a computer network to a network address for the user's computer;

transmitting a manufacturer's sample offer from said main computer over said computer network to said network address for said user's computer if said user's profile data meets user profile criteria associated with a manufacturer's sample offer for a sample of a product; and

generating instructions for providing said sample of said product to said user if said main computer receives a signal transmitted over said computer network indicating said user accepts said manufacturer's sample offer.

The examiner relies on the following reference:

Scroggie et al. (Scroggie) WO 97/23838 July 3, 1997

Claims 1-37 stand rejected under 35 U.S.C. § 102(b) as being anticipated by the disclosure of Scroggie. Rejections of claims 31, 34 and 37 under 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph, have been withdrawn by the examiner [answer, pages 3-4].

Rather than repeat the arguments of appellants or the examiner, we make reference to the brief and the answer for the respective details thereof.

OPINION

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of anticipation relied on by the examiner as support for the rejection. We have, likewise, reviewed and taken into consideration, in reaching our decision, the appellants' arguments set forth in the brief along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

It is our view, after consideration of the record before us, that the evidence relied upon supports the examiner's rejection of claims 1-37. Accordingly, we affirm.

Anticipation is established only when a single prior art reference discloses, expressly or under the principles of inherency, each and every element of a claimed invention as well as disclosing structure which is capable of performing the recited functional limitations. RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir.); cert. dismissed, 468 U.S. 1228 (1984); W.L. Gore and

Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).

The examiner has indicated in substantial detail how he has read the invention of each of claims 1-37 on the disclosure of Scroggie [answer, pages 5-16]. Appellants have nominally argued this rejection in eighteen different claim groupings. Each of the nominal groups indicated by appellants is argued by simply broadly asserting that the claims of each group recite limitations that are not disclosed by Scroggie [brief, pages 6-10]. These assertions by appellants are not accompanied by any analysis nor do they address the specific portions of Scroggie identified by the examiner as disclosing the specific features of the claims on appeal. The examiner responds to each of appellants' groups of claims by again specifically reading the claimed invention on the disclosure of Scroggie [answer, pages 16-39].

Since appellants' brief offers no substantive response to the examiner's rejection except to broadly disagree with it, we will consider appellants' position to be that the examiner's rejection fails to establish a prima facie case of anticipation. As noted above, however, the examiner's rejection goes into substantial detail as to how the claimed invention is fully met

by Scroggie. The examiner's explanation of the rejection is sufficient to establish a prima facie case of anticipation. Taking claim 1, for example, appellants broadly assert that Scroggie does not disclose depending the transmission of a manufacture's product sample offer to the user upon whether the user's profile data meet user profile criteria associated with the manufacturer's product sample offer [brief, page 6]. Other than this conclusory statement, appellants provide no further discussion. The examiner's rejection indicates that user profile data can include zip code, preferences and buying pattern, and the rejection points to portions of Scroggie where this profile data is used to determine what offers to make to a given user. We agree with the examiner that this data in Scroggie constitutes profile data which is used to match profile criteria for a given product. Therefore, the rejection has established a prima facie case of anticipation. Since appellants have not presented any substantive arguments to support their position that the examiner's position is incorrect, we sustain the examiner's rejection. This same type of analysis can be applied to each of the claims on appeal.

In summary, we find that the examiner has established a prima facie case of anticipation with respect to each of the claims on appeal, and appellants have failed to challenge this prima facie case with any substantive arguments. Therefore, the decision of the examiner rejecting claims 1-37 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

ERROL A. KRASS)
Administrative Patent Judge)
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JERRY SMITH) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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)
STUART S. LEVY)
Administrative Patent Judge)

JS/ki

Oblon, Spivak, McClelland
Maier & Neustadt, PC
1755 Jefferson Davis Highway
4th Floor
Arlington, VA 22202